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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/811,616	03/29/2004	Robert R. Parsons	0013	2720
43699 7590 05/11/2010 GO DADDY GROUP, INC. 14455 NORTH HAYDEN ROAD SUITE 219 SCOTTSDALE, AZ 85260				
EXAMINER				
STRODER, CARRIE A				
ART UNIT		PAPER NUMBER		
3689				
NOTIFICATION DATE		DELIVERY MODE		
05/11/2010		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

inventions@godaddy.com

Office Action Summary

Application No.

10/811,616

Applicant(s)

PARSONS, ROBERT R.

Examiner

CARRIE A. STRODER

Art Unit

3689

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 March 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/CD)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

3DETAILED ACTION

1. This is in response to the applicant's communication filed on 23 March 2010, wherein:

Claims 1-19 are currently pending.

Claim Rejections - 35 USC § 103

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. **Claims 1-3, 7-9, 13-15, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Go Daddy, www.godaddy.com, 02 February 2003 (hereinafter referred to as "Go Daddy", in view of Chauchard et al. (US 20020042719 A1), based on the same reasoning provided in Examiner's previous Office Action.**

Referring to claim 1:

Go Daddy teaches:

A) the Facilitator's web site allowing access to an Entrepreneur over the Internet (Section I);

B) the Facilitator's web site registering with a Registry a requested available domain name having a label and a top-level domain in response to the Entrepreneur's request for the domain name on the Facilitator's web site (Section II); and

wherein the Facilitator's web site is accessible to a plurality of Entrepreneurs over the Internet (page 1).

Go Daddy does not teach; however, Chauchard teaches

C) assisting the Entrepreneur in trademarking a name (paragraphs 75-80).

Considering Go Daddy and Chauchard as a whole, it would have been obvious to one skilled in the art at the time of the invention to provide a process implementing a website such as Go Daddy with modifications as taught in Chauchard because this would provide a manner in which to conveniently trademark a domain name simultaneously with registering said domain name.

Referring to claim 7:

Go Daddy teaches

A) the Facilitator's web site allowing access to an Entrepreneur over the Internet (Section I);

B) the Facilitator's web site offering hosting services on a hosting server for the Entrepreneur's web site at an Internet protocol address associated with a registered domain name having a label and a top-level domain (Section III; "Hosting"); and

wherein the Facilitator's web site is accessible to a plurality of Entrepreneurs over the Internet (page 1).

Go Daddy does not teach; however, Chauchard teaches

C) assisting the Entrepreneur in trademarking a name (paragraphs 75-80).

Considering Go Daddy and Chauchard as a whole, it would have been obvious to one skilled in the art at the time of the

invention to provide a process implementing a website such as Go Daddy with modifications as taught in Chauchard because this would provide a manner in which to conveniently trademark a domain name simultaneously with receiving hosting services for the website associated with the domain name.

Referring to claim 13:

Go Daddy teaches:

A) the Facilitator's web site allowing access to an Entrepreneur over the Internet (Section I);

B) the Facilitator's web site registering with a Registry a requested available domain name having a label and a top-level domain in response to the Entrepreneur's request for the domain name on the Facilitator's web site (Section II);

C) the Facilitator's web site offering hosting services on a hosting server for the Entrepreneur's web site at an Internet protocol address associated with a registered domain name having a label and a top-level domain (Section III; "Hosting"); and

wherein the Facilitator's web site is accessible to a plurality of Entrepreneurs over the Internet (page 1).

Go Daddy does not teach; however, Chauchard teaches

C) assisting the Entrepreneur in trademarking a name (paragraphs 75-80).

Considering Go Daddy and Chauchard as a whole, it would have been obvious to one skilled in the art at the time of the invention to provide a process implementing a website such as Go Daddy with modifications as taught in Chauchard because this would provide a manner in which to conveniently trademark a domain name simultaneously with registering said domain name and with receiving hosting services for the website associated with the domain name.

Referring to claims 2, 8, and 14:

Claims 2, 8, and 14 are dependent on claims 1, 7, and 13; therefore, the rejections of claims 1, 7, and 13 are incorporated herein.

Go Daddy teaches assisting the Facilitator's web site assisting the Entrepreneur in selecting an available domain name based on one or more words chosen by the Entrepreneur to describe the Entrepreneur's business (Section II).

Referring to claim 3, 9, and 15:

Claims 3, 9, and 15 are dependent on claims 1, 7, and 13; therefore, the rejections of claims 1, 7, and 13 are incorporated herein.

Go Daddy teaches the Facilitator's web site submitting an Entrepreneur's web site associated with the registered domain

name to one or more search engines (Section III, as explicated by Section IV).

Referring to claim 19:

Go Daddy teaches:

A) the Facilitator's web site allowing access to an Entrepreneur over the Internet (Section I); and

B) the Facilitator's web site receiving information regarding the Entrepreneur that has accessed the Facilitator's web site (Section I).

C) the Facilitator's web site storing the information regarding the Entrepreneur in a memory location accessible by the Facilitator's web site (Section I);

D) the Facilitator's web site registering with a Registry a requested available domain name having a label and a top-level domain in response to the Entrepreneur's request for the domain name on the Facilitator's web site (Section II).

Go Daddy and Chauchard teach

E) the Facilitator's web site assisting the Entrepreneur in trademarking the domain name or the label with the United States Patent and Trademark Office using at least some of the stored information regarding the Entrepreneur, wherein the Facilitator's web site is accessible to a plurality of

Entrepreneurs over the Internet (Go Daddy, page 1 and Chauchard, paragraphs 75-80).

Considering Go Daddy and Chauchard as a whole, it would have been obvious to one skilled in the art at the time of the invention to provide a process implementing a website such as Go Daddy with modifications as taught in Chauchard because this would provide a manner in which to conveniently trademark a domain name simultaneously with registering said domain name and with receiving hosting services for the website associated with the domain name.

3. **Claims 4-6, 10-12, and 16-18 are rejected** under 35 U.S.C. 103(a) as being unpatentable over Go Daddy in view of Chauchard, as applied to claims 1-3, 7-9, 13-15, and 19, above, and further in view of the United States Patent and Trademark Office, www.uspto.gov, 29 February 2000 (hereinafter referred to as "USPTO") based on the same reasoning provided in Examiner's previous Office Action.

Referring to claims 4, 10, and 16:

Go Daddy and Chauchard fail to teach; however, USPTO teaches linking the Entrepreneur with the official web site for the United States Patent and Trademark Office (Section I).

Considering Go Daddy, USPTO, and Chauchard as a whole, it would have been obvious to one skilled in the art at the time of

the invention to provide a process implementing a website such as Go Daddy with modifications as taught in Chauchard and USPTO for facilitating steps in registering domain names simultaneously with applying for trademarks before the USPTO.

Referring to claims 5, 11, and 17:

Go Daddy and Chauchard do not teach; however, USPTO teaches the steps of receiving trademark information from the Entrepreneur, creating hardcopy trademark forms containing the trademark information, transmitting the hardcopy trademark forms to the Entrepreneur and instructing the Entrepreneur in the procedure for submitting the hardcopy trademark forms to the United States Patent and Trademark Office (Section III).

Considering Go Daddy, USPTO, and Chauchard as a whole, it would have been obvious to one skilled in the art at the time of the invention to provide a process implementing a website such as Go Daddy with modifications as taught in Chauchard and USPTO for facilitating steps in registering domain names simultaneously applying for trademarks before the USPTO.

Referring to claims 6, 12, and 18:

Go Daddy and Chauchard do not teach; however, USPTO teaches the steps of receiving trademark information from the Entrepreneur, creating electronic trademark forms containing the trademark information and electronically submitting the

electronic trademark forms to the United States Patent and Trademark Office (Section II).

Considering Go Daddy, USPTO, and Chauchard as a whole, it would have been obvious to one skilled in the art at the time of the invention to provide a process implementing a website such as Go Daddy with modifications as taught in Chauchard and USPTO for facilitating steps in registering domain names simultaneously with applying for trademarks before the USPTO.

Response to Arguments

Applicant's arguments filed 23 March 2010 have been fully considered but they are not persuasive.

I. Applicant first argues that the prior art does not teach assisting an Entrepreneur who has a domain name registered by a Facilitator's web site, in trademarking the domain name or label of the domain name. Examiner respectfully disagrees. Examiner points out that the rejection is based upon a *combination of references*, which must be read together; one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Chauchard teaches registering a trademark; as any mark used in interstate commerce may be registered, it would have been

obvious to a person having ordinary skill in the art at the time of the invention to combine Go Daddy and Chauchard in order to trademark domain names. Applicant seems to put a lot of weight on the limitation of an "Entrepreneur"; however, the fact that a user is an entrepreneur, rather than simply a "user" is a difference without a patentable distinction over the prior art.

II. Applicant also argues that the prior art does not teach an Entrepreneur trademarking the domain name or the label of a domain name. Applicant argues that the OA seems to be incomplete. However, applicant does not seem to be considering the following statement, quoted directly from the OA:

"Considering Go Daddy and Chauchard as a whole, it would have been obvious to one skilled in the art at the time of the invention to provide a process implementing a website such as Go Daddy with modifications as taught in Chauchard because this would provide a manner in which to conveniently trademark a domain name simultaneously with registering said domain name."

III. Examiner replies to this argument in Section I, *supra*.

IV. Comment on Applicant's Response to the OA's Response to Arguments. Examiner respectfully disagrees with applicant's arguments and reiterates the Examiner's previously articulated response to arguments. Applicant argues that *KSR*, *Adams*, and

Anderson are not applicable as the above elements articulated in applicant's sections 1, 2, and 3 are not found in the prior art. Examiner respectfully disagrees and has shown, above, that these elements are in fact found in the prior art.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Contact

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CARRIE A. STRODER whose telephone number is (571)270-7119. The examiner can normally be reached on Monday - Thursday 8:00 a.m. - 5:00 p.m. ET.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jan Mooneyham can be reached on (571)272-6805. The fax phone number for the

organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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